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09/481,988	01/11/2000	PAUL J. BRUINSMA	1941-70	6422

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EXAMINER

MARCANTONI, PAUL D

ART UNIT PAPER NUMBER

1755

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040315

Application Number: 09/481,988
Filing Date: January 11, 2000
Appellant(s): BRUINSMA ET AL.

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GROUP 1700

BRUINSMA ET AL.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/5/04.

Art Unit: 1755

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

No other appeals or interferences are pending with regard to this application.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. Further, Appellants merely failed to file a divisional application for the "product" claims that were non-elected and they now attempting to improperly recapture. The process claims were examined, allowed and issued. Appellants are attempting to overcome their failure to file a divisional application for the product claims from their Bruinsma patent disclosure through this re-issue application. Yet, this is not considered an error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by re-issue of the original patent under 35 USC 251. In re Watkinson, 900 F2d 230, 14 USPQ 2d 1407 (Fed Cir.

Art Unit: 1755

1990); In re Orita, 550 F2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977) See also In re Mead, 581 F2d 251, 198 USPQ 412 (CCPA 1978) See MPEP 1450-51.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 188 and 189 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 129-187 are allowable.

Claims 188 and 189 are rejected under 35 USC 251 as being an improper recapture of the claimed subject matter deliberately canceled in the application for patent upon which the present re-issue is based and a reissue appellant's failure to file a divisional application is not considered to be an error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 USC 251. In re Watkinson, 900 F2d 230, 14 USPQ 2d 1407 (Fed Cir. 1990); In re Orita, 550 F2d 1277, 1280, 193 USPQ

Art Unit: 1755

145, 148 (CCPA 1977) See also *In re Mead*, 581 F2d 251, 198 USPQ 412

(CCPA 1978) See MPEP 1450-51.

(11) Response to Argument

The appellants admit and acknowledge they canceled the claims and failed to file a divisional application to product claims non-elected which is certainly the proper course of action. Appellants are attempting to rectify their error, albeit improperly, by re-issue to the product claims for which they failed to file a divisional application. Yet, it is well established that it is impermissible to recapture subject matter in situations of appellants failure to file a divisional application to the non-elected invention (ie product claims).

Appellants ignore MPEP 1450-51 and the large listing of case law above making it quite clear that recapture is not permissible for their product claims because of failure to file a divisional application to them. Instead, they focus on the examiner's mistake in wrongly indicating allowable product claims. The examiner readily acknowledges his error that he should never have indicated that product claims were allowable. However, he rectified the error and held all product claims 188-189 (and all other product claims in prosecution) as rejected under 35 USC 251 based upon improper recapture. The appellants also focus on differences between product claim 28 and 188 and 189 and state that they are *very* different.

The examiner disagrees. Claim 28 claims a *calcined, mesoporous silica thin film on a substrate* having a certain d spacing and claims 188-189 are

Art Unit: 1755

directed to a *calcined, mesoporous silica thin film on a substrate* made by a particular and very specific process. In other words, claim 28 is merely a product claim and claims 188-189 are product by process claims both claiming the same thin film. In rebuttal, claim 28 is made by the same process as claims 188-189 and merely because it is not stated does not make it evident to one of ordinary skill in the art that the process steps were both gleaned from the same disclosure. In fact, it does not seem the process of making the thin film of claim 28 is any different than claims 188 and 189. Both are made by the same process of the disclosure.

Even if the processes were different, which, they apparently are not, "product by process claims do not patentably distinguish the product of reference even though made by a different process." In re Thorpe , 227 USPQ 964. The appellants indicate the examiner stated that, for example, ceramic materials can be made by sol gel, organometallic synthesis, solid state sintering, etc. and the final ceramic product is still the same. They argue that In re Thorpe can be used in an argument only over prior art. The examiner disagrees. It is true it can be used in a prior art rejection to show the product is the same even though made by a different product.

However, that is not why In re Thorpe was presented. It was presented to show proper reasons why restriction could have been possible between the appellants' process and thin film product by showing that the non-elected product can be made by other different processes. This is the requirement of a proper restriction requirement. In other words, if the examiner can show that the product

Art Unit: 1755

can be made by a materially different process (sol gel, solid state sintering, etc.), then restriction is proper. Thus, *In re Thorpe* does apply.

The appellants also admit on page 8 of their appeal brief that they *did not traverse the restriction* at the time of the original restriction prior to allowance to the process claims of the Bruinsma patent and cancellation of the product claims. Yet, they present a scenario of stating that had claims 188-189 (product claims with the added process limitations) been in the parent they would have traversed the restriction requirement. In rebuttal, the examiner cannot act nor comment on possibilities, scenarios, or actions that never occurred. It is on record that they did not traverse the original restriction between product and process claims. Further, the product claims of the original patent are still made by the same process of the original disclosure which is also the same as the process limitations of claims 188-189. These product claims most certainly would have been grouped with the other product claims because they are made by the same process within the teaching of their disclosure.

In summary, re-issue is not a proper remedy for appellants' failure to file a divisional to product claims in their parent application that were non-elected and canceled. The proper course is filing a divisional and appellants neglected to do so. This is unfortunate for appellants. However, the rejection under 35 USC 251 regarding appellants' recapture of canceled subject matter (ie product claims) should be sustained.

Art Unit: 1755

For the above reasons, it is believed that the rejections should be sustained.

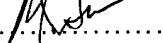
Respectfully Submitted,




Paul Marcantoni
Primary Examiner
Art Unit 1755

March 23, 2004

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